

R E M A R K S

Minor editorial revisions were made to claims 46 to 50, 68, 69, 71 and 84.

New claim 119 recites the species elected in reply to the November 19, 2004 Restriction Requirement. New claim 119 is supported in the specification by compound 2-92 in the table on page 31 and Examples 125 (page 201) and 95 (racemate) (page 184).

Method claims 102 to 118 were amended to delete the term "preventing" as suggested by the Examiner in the paragraph bridging pages 4 and 5 of the Office Action to obtain rejoinder of the method claims, following allowability of the compound claims. Minor editorial revisions were also made to method claims 102 to 118.

Applicants are pleased to note that the Office Action did not include any prior art rejections.

Claims 69, 72, 80 and 85 to 92 were rejected under 35 USC 112, second paragraph, for the reasons set forth at the middle of page 3 of the Office Action.

It was alleged in the Office Action that claims 68 and 69 are duplicates.

Claims 68 and 69 are not duplicates, since whereas Arom in claim 69 is only a phenyl group, Arom in claim 68 is a phenyl group or a pyridyl group.

It was alleged in the Office Action that claims 79 and 80 are duplicates.

Claims 79 and 80 are not duplicates, since claim 79 recites that R¹ can be a di(C₁-C₆ alkyl) amino group, and claim 80 recites R¹ can be a di(C₁-C₄ alkyl) amino group.

It was alleged in the Office Action that claim 72 improperly depends from claims 46 to 52 for failure to limit the scope of the independent claims. Applicants respectfully disagree with the Examiner that claim 72, which recites that A is a C₁-C₄ alkylene group fails to limit the scope of claims 46 to 52, which recite that A is a C₁-C₆ alkylene group.

It was alleged in the Office Action that the term "containing" in line 1 of claims 85 to 92 renders the claims indefinite. According to the MPEP 2111.03, the term "containing" is synonymous with the term "comprising." However, to reduce issues, claims 85 to 92 were amended to replace "containing" with --comprising--.

In view of the above, withdrawal of the 35 USC 112, second paragraph rejection is respectfully requested.

In reply to applicants' species election for search purposes made in response to the November 19, 2004 Office Action, the Examiner examined a "subgeneric scope" of the claims as set forth on page 3 of the Office Action and withdrew from consideration the remaining subject matter included in claims 46 to 92. Such "subgeneric scope" of the claims was not rejected over any prior art. Claims 46 to 92 were objected to for containing non-elected subject matter, as stated in the last full paragraph on page 4 of the Office Action.

Thus, for an election of species for search purposes only (in reply to the November 19, 2004 Office Action), the February 22, 2005 Office Action "jumped" to a restriction between a "Group (i)", namely R^1 and X^1 as defined in the claims; X^2 is oxygen; R^a as defined in the claims, but would not combine together with R^2 ; R^2 is H; R^3 is alkyl; A is $-C_2H_4-$, E is oxygen and Arom is optionally substituted phenyl, and a "Group (ii)", namely the remainder of the claimed subject matter.

Such purported restriction between said "Group (i)" and said "Group (ii)" had not previously been set forth as a Restriction Requirement under 35 USC 121, and applicants were not afforded an opportunity to elect and respond to said purported Restriction

Requirement. The election between said "Group (i)" and said "Group (ii)" was in effect made for the applicants by the USPTO.

Applicants traverse such purported Restriction Requirement between the aforesaid Group (i) and the aforesaid Group (ii).

The purported Restriction Requirement is traversed because the February 22, 2005 Office Action did not establish a *prima facie* case for restricting the claims, because no reasons were furnished to justify restriction on the basis of any of (a) a separate classification, (b) a separate status in the art, or (c) a different field of search.

When an election of species is required of applicants, the Examiner is obligated to follow the guidelines set forth in MPEP 802.03. This was not done in the February 22, 2005 Office Action.

It is not proper to first require an election of species and then to make or consider such election of species to be a response to an unexpressed restriction requirement, which was done in the February 22, 2005 Office Action.

Once having identified the entire claim as being subject to an election of species, the Examiner has *sub silentio*, stated that all the compounds are so related that search and examination of the elected species, providing no prior art is found, would lead to expansion of that search to a reasonable number of related

species to determine their patentability. If no prior art is found on the additional related species, then the entire claim and all species encompassed therewith are considered patentable. This was not done.

In view of the Examiner's requirement for an election of species, rather than an election of a separate and distinct invention, the Examiner is respectfully requested to follow the guidelines of MPEP 802.03 with respect to the elected species (for which no prior art is indicated as having been found) and to expand the examination to additional related species (for which it also appears that no prior art has been found) and continue the prosecution of this application.

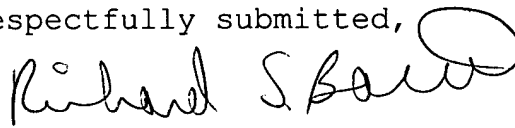
In view of the above, withdrawal of the objection of claims 46 to 92 and examination of the entire scope of the claimed subject matter is respectfully requested.

Reconsideration is requested. Allowance is solicited.

A check for \$50 is enclosed in payment of an additional claim.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Richard S. Barth".

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Enclosure: Check for \$50